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MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			EXAMINER CHENCINSKI, SIEGFRIED E	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/051,355
Filing Date: January 18, 2002
Appellant(s): GHAFOOR ET AL.

Gregory A. Welte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2008 appealing from the Office action mailed October 18, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010056402	AHUJA ET AL.	12-2001
9194414	SAVAGE	3-2007

6430496	SMITH ET AL.	08-2002
6327348	WALKER ET AL.	12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(9) A. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 12 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Applicant's specification. In that paper, applicant has stated:

"The present invention relates to a self-service terminal (SST) and to a method of operating an SST. In particular, the invention relates to an automated teller machine (ATM), and to a method of operating an ATM.

ATMs provide users with a convenient source of cash in an unattended environment. However, to benefit from this convenience a user must be able physically to access an ATM, and must also be able to input data requested by the ATM such as a personal identification number (PIN), an amount of cash to be withdrawn, and such like data. As a result, certain people are not able to use ATMs, for example, because they are confined to a home, because they have a visual impairment, because an ATM is located in an area that is not physically accessible for them, or such like reason.

To overcome this problem, some people entrust their ATM card and PIN to a third party for conducting transactions on their behalf; but this is undesirable because it may lead to fraud, for example, if the third party withdraws more money than they are asked to withdraw, or if the third party makes unauthorized withdrawals.

It is among the objects of an embodiment of the present invention to obviate or mitigate one or more of the above disadvantages, or other disadvantages associated with conventional SSTs.

According to a first aspect of the present invention there is provided a self-service terminal having a user interface including means for identifying a user, characterized in that the terminal includes means for obtaining contact

information for a communications device associated with a user; and contact means for establishing a link with the communications device to allow a transaction to be entered thereby.

Preferably, an entire transaction is entered using the communications device, where an entire transaction includes entry of an identification, such as a PIN, and entry of transaction data, such as an amount of money to be withdrawn.

The communications device is retained by a user, and is used as an alternative to any input device on the SST, such as a keypad, touchscreen, function display keys (FDKs), or such like. Thus, the communications device is used as an alternative input means.

In one embodiment, the communications device is located remotely from the SST during a transaction. This allows a person ("the user") to enter a transaction at a remote location while another person, who is located at the SST, receives any item dispensed from the SST as a result of the transaction entered by the user.

By virtue of this embodiment of the invention an account holder ("the user") who is unable to access or use an ATM is able to provide a third party with a token that the third party presents to the ATM. The account holder ("the user") is contacted by the ATM when a transaction is to be entered. The account holder can then enter a security code (such as a PIN) and transaction details (such as withdraw twenty pounds sterling). This enables an account holder to allow a third party to collect money or other media from their account using an ATM, without having to divulge a PIN or other security code to the third party, thereby minimizing the potential for abuse of trust."

In another embodiment, the communications device is located locally at the SST during a transaction so that the person who operates the communications device ("the user") is the person who receives any item dispensed from the SST as a result of the transaction.

By virtue of this embodiment of the invention, a self-service terminal

is operable to identify a user and to dial a user's telephone so that the user can enter a transaction using the telephone rather than the terminal's user interface. One advantage of this embodiment of the invention is that the user does not have to determine the telephone number of the SST, because the SST calls the user's communications device once the user has been identified. For a visually-impaired user who has no difficulty in physically accessing an SST, this obviates any requirement for a third party to assist with a transaction. (Specification, p. 1, l. 3 – p.2, l. 28).

This statement indicates that the invention is different from what is defined in the claim because the claim's elements fail to embody even one full embodiment of Applicant's invention in the functional limitations. "enabling the ATM to contact ..." and ... "so that a transaction may be entered" are non-functional descriptive language.

(9) B. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (US PreGrant Publication 2001/0056402 A1) in view of Savage et al. (US Patent 7,194,414 B1, hereafter Savage).

Re. Claims 1, 11 & 12, Ahujah discloses a method, system and an apparatus for accessing financial information or conducting financial transactions and, more particularly, to an improved system and method for accessing financial information or conducting financial transactions using wireless communications devices, such as cellular telephones, personal digital assistants, and other web-enabled wireless devices (Abstract). This includes operating an Automated Teller Machine, ATM, the method comprising the steps of:

- (a) identifying a user (Fig's 1 & 2, reading a card through a card reader in the communications front end);
- (c) establishing a telecommunications link with the communications device (p. 2, [0038]-ll. 4-6; [0017]-ll. 4-6).

Ahujah does not explicitly disclose (b) obtaining contact information with the identified user.

However, Savage discloses obtaining contact information with the identified user (Col. 4, ll. 15-18).

The phrases "which enables the ATM to contact a communications device associated" and "so that a transaction may be executed via the link" are non-functional descriptive information and therefore carry no patentable weight.

Regarding claim 11, it has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced" (MPEP 2144.04 B, *In re Harza*). Claim 11 has no added patentable significance over the single ATM of claim 1 and 12 since no unexpected result is claimed or contained in the disclosure.

Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage in order to establish a method, system and an apparatus for operating one or more Automated Teller Machine(s), ATM('s), which includes establishing a telecommunications link with the communications device(s) so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user (Col. 1, ll. 7-8).

Re. Claims 3 & 14, Ahujah discloses directly establishing a telecommunications link with the communications device (p. 3, ll. [0046],[0047]).

Re. Claims 4 & 15, Ahujah discloses requesting a remote transceiver to establish a telecommunications link with the communications device (p. 3, ll. [0046],[0047]).

Re. Claims 5 & 16, a summary of the disclosures by Ahujah are contained in the rejection of independent claim 12 above.

Ahujah discloses method of operating an automated teller machine (ATM), the method comprising the steps of:

- (a) identifying an ATM customer desiring to carry out an ATM transaction (Fig's 1 & 2, reading a card through a card reader in the communications front end);
- (c) establishing a link with the communications device associated with the ATM customer (p. 2, [0038]-ll. 4-6; [0017]-ll. 4-6).

Ahujah does not explicitly disclose (b) obtaining contact information with the identified ATM customer. However, Savage discloses obtaining contact information with the identified ATM customer (Col. 4, ll. 15-18).

The phrases "which enables the ATM to contact a communications device associated" and "to allow the ATM customer to enter the desired transaction" are non-functional descriptive information and therefore carry no patentable weight.

Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage in order to establish a method, system and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user (Col. 1, ll. 7-8).

Re. Claim 6, please see an overview of the disclosure of Ahujah in the rejection of claims 1 and 12. Ahujah discloses a means for establishing a link with the communications device based upon the obtained contact information to allow the ATM customer to enter an ATM transaction (Fig's 1 & 2, reading a card through a card reader in the communications front end; p. 2, [0038]-ll. 4-6; [0017]-ll. 4-6).

Ahujah does not explicitly disclose a) a cash dispenser for dispensing cash; means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed; and means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer. However, Savage discloses a cash dispenser for dispensing cash; and means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer (Col. 4, ll. 15-18). Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage in order to establish a method, system and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user (Col. 1, ll. 7-8).

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Re. Claim 8, Ahujah discloses wherein the contact means includes means for directly contacting the communications device associated with the ATM customer (p. 3, ll. [0046],[0047]).

Re. Claim 9, Ahujah discloses wherein the contact means includes means for requesting a remote transceiver to establish a link with the communications device associated with the ATM customer (p. 3, [0044]-[0050]).

Re. Claim 10, please see an overview of the disclosure of Ahujah in the rejection of claims 1 and 12. Ahujah also discloses means for obtaining a telephone number for a telephone associated with an ATM customer (p. 3, [0044]-[0050]); and means for establishing a link with the telephone based upon the obtained telephone number to allow the ATM customer to enter an ATM transaction (Fig's 1 & 2, reading a card through a card reader in the communications front end; p. 2, [0038]-ll. 4-6; [0017]-ll. 4-6).

Ahujah does not explicitly disclose a) a cash dispenser for dispensing cash; means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed; and means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer. However, Savage discloses a cash dispenser for dispensing cash; and means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer (Col. 4, ll. 15-18). Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage in order to establish a method, system and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user (Col. 1, ll. 7-8).

Re. Claim 18, Ahujah discloses directly establishing the link with the communications device associated with the ATM customer (p. 3, [0044]).

Re. Claim 19, Ahujah discloses requesting a remote transceiver to establish the link with the communications device associated with the ATM customer (p. 3, [0044]-[0050]).

(9) C. Claims 2 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja in view of Savage as applied to the rejections of claims 2 and 13 above, and further in view of Official Notice.

Re. Claims 2 & 13, neither Ahujah nor Savage explicitly disclose retrieving a telephone number to be called to establish a telecommunications link with the communications device. However, the examiner takes Official Notice that financial account owner records usually contain telephone numbers for contacting the account owner/user. It would have been obvious to one of ordinary skill to have included system accessible telephone numbers available for contacting customer users. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage and Official Notice in order to establish a method, system and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user (Col. 1, ll. 7-8).

(9) D. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja in view of Savage as applied to the rejections of claim 6 above, and further in view of Official Notice.

Re. Claim 7, see the rejection of claims 2 & 13 regarding means for retrieving data relating to a telephone number to be called to establish a link with the communications device associated with the ATM customer.

(9) E. Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja in view of Savage as applied to the rejections of claims 16 and 17 above, and further in view of Walker et al. (US Patent 6,327,348 B1, hereafter Walker).

Re. Claim 17, cash is the most notable of the items of value delivered through ATM's. Ahujah does not explicitly disclose the dispensing of cash. However, Savage discloses the dispensing of cash through an ATM (Col. 2, l. 67 – Col. 3, l. 1). Further, neither Ahujah nor Savage explicitly disclose delivering an item of value to a second person located at the ATM, who is different from the customer. However, Walker discloses a financial transaction in which a "first person" may authorize a transaction between the second person and a third party (e.g. a merchant) (Abstract, ll. 2-7). One of ordinary skill in the art would have seen it as obvious to have applied Walker's teaching to an ATM transaction situation where the authorizer approves a transaction involving the delivery of an item of value from their account by the second person. Therefore, a practitioner of the art at the time of Applicant's invention would have found it obvious to have combined the disclosures of Ahujah, Savage and Walker for the purpose of designing a method, system and an apparatus of operating an automated teller machine (ATM) in which a transaction which involves the use of a PIN and two persons, motivated by a desire to permit a first person to control the authorization or denial of a transaction executed by a user based on circumstances surrounding the transaction (Abstract, ll. 16-18).

Re. Claim 20, Ahujah discloses the use of an ATM in which the identified person delivers a Personal Identification Number, PIN, to the ATM (p. 4, [0052]-ll. 4-5). Neither Ahujah nor Savage explicitly disclose a second person. However, Walker discloses a financial transaction in which a "first person" may authorize a transaction between the second person and a third party (Abstract, ll. 2-7). In this case the authorizing person is the only one who needed to provide a PIN number while the recipient did not need to provide such a security hurdle. One of ordinary skill would have seen it as obvious to have included the use of a PIN for approval of a financial transaction involving their financial account involving a second person at an ATM. Therefore, a practitioner of the art at the time of Applicant's invention would have found it obvious to have combined the disclosures of Ahujah, Savage and Walker for the purpose of designing a method, system and an apparatus of operating an automated teller machine (ATM) in which a transaction which involves the use of a PIN and two persons, motivated by a desire to

permit a first person to control the authorization or denial of a transaction executed by a user based on circumstances surrounding the transaction (Abstract, ll. 16-18).

(10) Response to Argument

ARGUMENT A: Re. the Rejection of Claim 12 under 35 USC 112.

1. Claim 12 was a part of the original disclosure and thus is part of the subject matter which Appellant regards as his invention (p. 22, Point 4).

2. The Office Action fails to provide sufficient evidence that the claim is not supported by the original disclosure (pp. 20 - 24, points 1-3 and 5-7).

RESPONSE:

1. Appellant amended the original claim 12, element (b) from "obtaining contact information for a communications device associated with the identified user" to "obtaining contact information which enables the ATM to contact a communications device associated with the identified user". This amendment changed the broad meaning of the claim by narrowing it and specifying a particular capability for enabling the ATM to contact a communications device associated with the identified user. This change forced the examiner to look in the remaining parts of the disclosure for support of claim 12. has pointed out the missing limitations in the disclosure, namely that "obtaining contact information which enables the ATM to contact a communications device associated with the identified user" are not found in the disclosure, meaning that it is not in the original claim 12 and also not in the specification. The examiner has

presented portions of the specification in the rejection as an illustration of the missing disclosure.

ARGUMENT B: Claim elements are missing from the references (pp. 14-15, Point 1).

RESPONSE:

1. The US Supreme Court, in the KSR decision of April 2007, reinforced the *In re Kahn* guidelines for a *prima facie* case of obviousness. These guidelines are:

The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396. The court also added common sense as legitimate considerations.

In the instant case, the examiner believes that the rejections have followed these guidelines. This means that not every claim element must be disclosed in a reference when certain knowledge is attributed to the ordinary practitioner of the art at the time of Appellant’s invention and what would have been obvious to him. Further, the claims produce predictable results. The examiner believes that the rationale presented in the above rejections properly meets the *In re. Kahn* guidelines.

ARGUMENT C : “Office Action Ignores Claim Recitations” (pp. 15-17, Point 2). Appellant focuses on the phrases which the examiner deemed to be non-functional descriptive language in the context of the claim as follows: “which enables the ATM to

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contact a communications device associated" and "so that a transaction may be executed via the link" (p. 16, ll. 1-5).

RESPONSE:

Case law Guidance: "the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. **See *In re Lowry***, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); ***In re Ngai***, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004)."

In the instant case, the examiner deemed the two phrases being argued as not adding a new or unobvious functional relationship to the claim limitation.

ARGUMENT D: "No Teaching Given for Combining References" (pp. 17-20, top).

RESPONSE:

1. Case law provides the following guidelines: 'references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures'. ***In re Bozek***, 163 USPQ 545 9ccpa) 1969'. 'there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art'. ***In re McLaughlin*** 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).
2. In the instant case, the examiner has followed these guidelines, along with the above cited guidelines from ***In re Kahn*** in making a case of obviousness combination in the rejections.

ARGUMENT E: "This approach involves impermissible hindsight because, in essence, it does nothing more than

- i) outline the claimed invention, and
- 2) assert that the invention is obvious because of a five-word phrase in Savage.

That is hindsight. Essentially nothing in this rationale is found in the prior art, as required by the MPEP. "(p. 19, l. 1 – p. 20, l. 4; p. 19, l. 1 – p. 20, l. 4).

RESPONSE:

1. Case law provides the following guidelines: Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).
2. In the instant case, the examiner has followed these guidelines, along with the above cited guidelines from *In re Kahn* in making a case of obviousness combination in the rejections.

ARGUMENT F: Re. claims 5 and 10, "Point 4, ... Savage and Ahuja do not show obtaining a telephone number"(p. 20, Point 4).

RESPONSE: The rejection of independent claims 1, 11 and 12 shows an Ahuja reference for establishing a telecommunications link with the communications device ([0038]; [0017]). Savage discloses obtaining contact information with the identified user (Col. 4, ll. 15-18). Further, as presented re. claim 8, Ahujah discloses contact means for directly contacting the communications device associated with the ATM customer ([0046, [0047]). As presented re. claim 10, Ahujah discloses means for obtaining a telephone number for a telephone associated with an ATM customer (p. 3, [0044]-

[0050]); and means for establishing a link with the telephone based upon the obtained telephone number to allow the ATM customer to enter an ATM transaction (Fig's 1 & 2, reading a card through a card reader in the communications front end; p. 2, [0038]-II. 4-6; [0017]-II. 4-6). Further, in the rejection of claims 2 and 13, the rejection takes Official Notice which has not been traversed "that financial account owner records usually contain telephone numbers for contacting the account owner/user. It would have been obvious to one of ordinary skill to have included system accessible telephone numbers available for contacting customer users. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage and Official Notice in order to establish a method, system and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link, motivated by a desire to facilitate communication with a user".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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